

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Pellet and Sanchez-Martinez

Patent No. 6,126,944

Issued: October 3, 2000

Confirmation No. 9684

For: BACULOVIRUS EXPRESSION VECTORS
AND RECOMBINANT ANTIGENS FOR
DETECTING TYPE-SPECIFIC
ANTIBODIES TO HERPES SIMPLEX
VIRUS

FILED VIA EFS

Examiner: Kenya A. McLaughlin

Art Unit: 1623

Attorney Reference No. 6395-87124-02

FILED VIA ELECTRONIC FILING SYSTEM
COMMISSIONER FOR PATENTS

DECLARATION OF SUZANNE SEAVELLO SHOPE

1. I, Suzanne Seavello Shope, J.D. am employed by the United States of America as Represented by the Secretary of the Department of Health and Human Services (hereinafter "the Government"). I work for the Government in the Technology Transfer Office (TTO) at the Centers for Disease Control and Prevention (CDC) in Atlanta, Georgia as a Technology Licensing and Marketing Scientist. I received my law degree (J.D.) in 1992 from the University of California, Hastings College of Law. I was registered as a patent attorney in 1994 and worked as a patent associate at several law firms, including Jones and Askew and Kilpatrick Stockton, from 1994-2003. I have worked in my current position at CDC since April 2003, and have been Acting Director of the CDC TTO since January 1, 2012 at which time the prior Director Andrew Watkins retired from the CDC.

2. I was acting as the interim case manager for the above-referenced U.S. Patent No. 6,126,944 ("the '944 patent") from June 2007 until about April 14, 2008. This was during a period of transition in our office when the prior case managers (Russ Metler and Sumita Chowdhury-Ghosh) had left the CDC TTO, new case managers (Francisco Candal and Valentin Fikovsky) were transitioning into those responsibilities, and hundreds of our case files were

being transferred from our prior counsel (Needle & Rosenberg) to our patent firms who had been awarded a new patent services contract.

3. The April 3, 2008 due date for payment of the maintenance fee for the '944 patent was present in the CDC's Inteum C/S® Intellectual Property (IP) management system ("Inteum database") that has been used by the CDC since at least as early as 2004. A print-out of the Summary of Inteum entries for the '944 patent is attached as **Exhibit A**. The Inteum database is a commercially available IP management database that is widely used by technology transfer offices in the United States. Patent maintenance fee due dates were generated by the Inteum program when the issue date of a patent was entered into the database. For the '944 patent, the issue date was entered at about the time of the patent's issuance on October 3, 2000, and the payment of the 3.5 year maintenance fee was docketed, timely paid, and the entry completed in the database at that time. However, the 7.5 year initial maintenance fee payment date of April 3, 2008 occurred 12 days before Mr. Valentin Fikovsky began working as a Patent Advisor at the CDC Technology Transfer Office (TTO).

4. After assuming his responsibilities at CDC, Mr. Fikovsky inherited a large patent portfolio containing hundreds of cases each of which had multiple deadlines. The error leading to the expiration of this patent occurred in the context of the transfer of hundreds of files from the Government's prior patent counsel (Needle & Rosenberg) to new patent counsel and during a time of personnel transition at CDC TTO after the CDC TTO Patent Advisor Russ Metler left CDC in June 2007. Interim responsibility for the patent portfolio that Mr. Metler managed, which included the '944 patent, was transferred to me. In addition to my full-time Licensing and Marketing responsibilities, I was the contact person for the '944 patent until April 15, 2008 when Mr. Fikovsky began his job as a CDC TTO Patent Advisor.

5. Contemporaneous with these simultaneous transitions of files and Patent Advisors, the past due date for the initial payment of the maintenance fee was mistakenly overlooked by Mr. Fikovsky which caused timely payment of the maintenance fee to be missed. Although the maintenance fee date continued to appear as an uncompleted item assigned to Mr. Fikovsky for the '944 patent record in the Inteum database, he did not take steps to have the fee

paid by the October 3, 2008 deadline through one of the outside law firms contracted to pay the fees on behalf of CDC. Mr. Fikovsky has submitted a prior Declaration dated May 27, 2011 (paragraph 7) indicating that during the time period following May 15, 2008 he investigated directly paying this fee using a credit card or a maintenance fee payment agency. During that investigation he overlooked the October 3, 2008 final deadline for paying the maintenance fee. This error led to the non-payment of the fee by the October 3, 2008 deadline.

6. A copy of a Curriculum Vitae (CV) provided by Mr. Fikovsky to the Government is attached as an Exhibit to Mr. Fikovsky's Declaration, and it provides an explanation for the Government's reasonable reliance on Mr. Fikovsky's expertise to carry out his duties, arrange for the timely payment of maintenance fees, and take steps to timely revive any patents that expired contrary to the business and public health mission of the CDC.

7. In October 2008 when the maintenance fee was not paid, Mr. Fikovsky had only been working at the CDC TTO for about six months. However, as noted in his CV and Declaration, he had been registered as a patent agent since 1982, and he had previously held positions of responsibility such as Director of Patent Prosecution, Biomedical Licensing and Contract Administration from 1983 to 2004 at the University of California. His CV indicated that he was a Manager of Patent Prosecution Systemwide. From 2004 to 2008, Mr. Fikovsky had been the Director of Licensing at the University of Nevada at Reno/Desert Research Institute where we understood he gained additional expertise in the administration of patent portfolios. The CDC checked Mr. Fikovsky's references when he was applying for employment with the Government. The CDC was aware of Mr. Fikovsky's background and experience at the time Mr. Fikovsky began to work at CDC, and the Government placed reasonable reliance on him to perform his duties in view of his extensive prior experience with patent prosecution matters.

8. When Mr. Fikovsky assumed his role as a Patent Advisor at the CDC on April 15, 2008, I offered him training in docketing and management of his portfolio because I had been acting as the interim Patent Advisor for his portfolio. Mr. Fikovsky told me that in view of his extensive experience in the management of patent portfolios additional training was unnecessary. In view of his long career in patent prosecution management TTO reasonably relied on this

experience and expertise in these matters and gave him responsibility for managing his docket. Mr. Fikovsky was aware of the '944 patent and its maintenance fee, as evidenced by an email he sent to me on May 15, 2008 about the payment of its maintenance fee. However, as a result of an error and contrary to the desire of the Government, he did not arrange for the timely payment of the maintenance fee that was due for the '944 patent by the patent expiration date of October 3, 2008.

9. The PTO issued a Notice of Expiration for the '944 patent on November 3, 2008 and mailed it to Needle & Rosenberg, the Government's former counsel of record. Needle & Rosenberg forwarded the Notice of Expiration ("Notice") to the Government, and the Notice was received by the CDC TTO on November 28, 2008, which was the day after Thanksgiving. The TTO was short-staffed that day and the Inteum database Program Analyst, Ms. Veronica Brown, was not at the office when the Notice of Expiration arrived. In Ms. Brown's absence, Ms. Sharon Shropshire received the letter and gave it to Mr. Francisco Candal. The Notice was subsequently emailed to Ms. Brown on December 9, 2008 by Ms. Sherwood, but as a result of a docketing oversight by Ms. Brown the Notice was not docketed. If the Notice had been docketed, it would have indicated that the patent had expired and that expiration information would have prompted TTO personnel to seek revival of the patent. For example, as described in the Declaration of Donald Prather, he accessed the Inteum database entry for the '944 patent between about September 3, 2009 and March 2010 while he was working on a license agreement. When Dr. Prather consulted the Inteum database about the '944 patent the database indicated the patent was in good standing. Had the Notice of Expiration been docketed the expired status of the patent would have been noted and the appropriate steps taken to revive it then. However, in the absence of this database information and in view of the hundreds of active matters being prosecuted and maintained by CDC TTO, the petition to revive the '944 patent was not filed until after the status of the patent was checked on PAIR on April 13, 2011 when the Government was calculating the term of the patent.

10. All statements made herein and of my own knowledge are true and all statements made on information are believed to be true; and further, these statements were made with the knowledge that willful false statements and like are punishable by fine or imprisonment, or both.

under Section 1001 of Title 18 of the United States Code, and that any such willful false statements made may jeopardize the validity of the application or any patent issuing thereon.

3/27/12
Date

Suzanne Shope
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